

REMARKS

Summary of the Office Action

Claim 20 stands objected to because of a minor informality.

Claims 32 and 53 stand objected to under 37 CFR 1.75 as allegedly being a substantial duplicate of claims 15 and 52, respectively.

Claims 15-48 and 52-55 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Claims 15-18, 21, 26, 31-37 and 42-55 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,967,286 to Nomula et al. (hereinafter "Nomula").

Claims 15-17, 26, 52, 32-33, 53, 48-50 and 55 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,088,323 to Kobayashi et al. (hereinafter "Kobayashi").

Claims 20, 23, 38-41 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nomula in view of U.S. Patent No. 6,392,964 B1 to Koyata et al. (hereinafter "Koyata").

Applicants thank the Examiner for indicating that claims 19, 22, 24-25, and 27-30, while objected to as being dependent upon a rejected base claim, would be allowable if rewritten in independent form and if rewritten to overcome the rejections under 35 U.S.C. § 112, second paragraph.

Summary of the Response to the Office Action

Applicants have canceled claims 52-55 without prejudice and disclaimer, and amended claims 15, 19, 20, 27, 29, 30, 32, 33, 47 and 48 to differently define the invention and to improve the form of the claims. Accordingly, claims 15-51 remain pending for further consideration.

The Objections to Claims 20, 32 and 53

Claim 20 stands objected to because of a minor informality, and claims 32 and 53 stand objected to under 37 CFR 1.75 as allegedly being a substantial duplicate of claims 15 and 52, respectively.

Since Applicants have canceled claims 52-55, the objection of claim 53 has been rendered moot.

Applicants have amended claims 20 and 32 to respond to the Examiner's objections and adopt the Examiner's helpful suggestions. Accordingly, it is respectfully requested that all objections to the claims be withdrawn.

The Objections to Claims 19, 22, 24-25 and 27-30

Applicants thank the Examiner for indicating that claims 19, 22, 24-25, and 27-30, while objected to as being dependent upon a rejected base claim, would be allowable if rewritten in independent form and if rewritten to overcome the rejections under 35 U.S.C. § 112, second paragraph.

Since Applicants have rewritten claims 19, 27, 29 and 30 in independent form including all of the limitations of the base claim and any intervening claims, Applicants

respectfully submit that newly-amended claims 19, 27, 29 and 30 are allowable and claims 22, 24-25 and 28 are also allowable because of their dependencies upon respective claim 19 and 27, as newly amended.

The Rejections under 35 U.S.C. § 112, second paragraph

Claims 15-48 and 52-55 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Since Applicants have canceled claims 52-55, the rejections of claims 52-55 have been rendered moot.

With regard to claims 15-48, Applicants have amended claims 15, 32, 33, 47 and 48 in accordance with the Examiner's comments. Applicants respectfully submit that claims 15, 32, 33, 47 and 48 fully comply with the requirements of 35 U.S.C. § 112, second paragraph. Accordingly, Applicants respectfully request that the rejections of claims 15, 32, 33, 47 and 48 under 35 U.S.C. § 112, second paragraph, be withdrawn. Furthermore, Applicants respectfully submit that the rejections of claims 16-31, 34-36, 49-51 should also be withdrawn because of their direct or indirect dependencies upon respective independent claims 15, 32 and 48.

The Rejections under 35 U.S.C. § 102(b) and § 102(e)

Claims 15-18, 21, 26, 31-37 and 42-55 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Nomula. Claims 15-17, 26, 52, 32-33, 53, 48-50 and 55 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Kobayashi. To the extent that these

rejections might be reapplied to the claims as newly-amended, it is respectfully traversed as being based on a reference that neither teaches nor suggests the novel combination of features recited in the claims.

Since Applicants have canceled claims 52-55, the rejections of claims 52-55 have been rendered moot.

With respect to independent claims 15, 32, 47 and 48, as newly amended, Applicants respectfully submit that Nomula does not teach or suggest the claimed combination wherein “said optical recording medium is a recordable optical disc which is readable by a disc player.”

Nomula is directed to a method and apparatus for providing a graphical image on an optical recording disc. For example, Fig. 1 of Nomula shows a compact disc 10 which is provided with a graphical image formed in accordance with the described method. As shown in Fig. 1, the compact disc 10 includes a recording surface 12 where audio information in a conventional manner is stored, a text surface 14 where an alphanumeric, human readable text in the conventional manner is stored, and an image surface 16 where at least one image 18 is made up of a foreground 20 on a background 22. Moreover, Nomula discloses, at lines 15 to 25 of column 3, that “[i]n alternate embodiments the pits 26 can be used to define either the foreground 20 or the background 22,” “[t]he pits 26 used to define the image 18 are substantially the same in depth as pits used to record audio information in the recording surface 12, and in a replica disc they are formed in the same pressing operation form a master,” and “[t]he system described below forms both the image 18 and the recorded audio information on the recording surface 12 on the master in the same mastering process.”

Applicants respectfully submit that the disclosure of Nomula is directed to the information of an image and audio information on the recording surface of a master CD from which a replica disc is produced by the pressing process. Unlike Nomula, the present application is characterized in that the pit art data is written in a write-once type disk such as a CD-R or a rewritable disk such as a CD-RW.

Applicants respectfully submit that the master disk produced by the method and apparatus of Nomula is not used for the reproduction by a disk player. In other words, in order to form a surface configuration representing recorded information, a master disk needs to be processed by a developing process by which the photo-resist layer formed on the disk surface is selectively removed. Further, the master disk undergoes a metalizing process so that the developed resist layer is coated with a metal. After these processes, the surface configuration of the master disk processed by the developing process is transferred to a stamper which is used for a pressing operation described in Nomula.

Therefore, Applicants respectfully submit that Nomula does not teach or suggest the claimed combination wherein “said optical recording medium is a recordable optical disc which is readable by a disc player,” as recited by independent claims 15, 32, 47 and 48, as newly amended.

With respect to independent claims 15, 32, 47 and 48, as newly amended, Applicants respectfully submit that Kobayashi does not teach or suggest the claimed combination wherein there is a “change in optical characteristic of the recording layer where pits are formed with the light as compared to a pit-less portion where pits are not formed.”

Kobayashi discloses an optical modulator 52, as shown in Fig. 6, that is driven to switch the light quantity of a laser beam L, from the light quantity of 100% to the light quantity of 85%. Consequently, as described at lines 55-59 of column 10 and further illustrated by Fig. 8 of Kobayashi, the characters, image and the like are recorded on the surface of the disk. In other words, Kobayashi, as described at lines 22-30 of column 11, discloses the formation of a visible image by changing the width of the pits formed on the disk.

Therefore, Applicants respectfully submit that Kobayashi does not teach or suggest the claimed combination wherein there is a "change in optical characteristic of the recording layer where pits are formed with the light as compared to a pit-less portion where pits are not formed," as recited by independent claims 15, 32, 47 and 48, as newly amended.

Accordingly, Applicants respectfully assert that the rejections under 35 U.S.C. § 102(b) and § 102(e) should be withdrawn because the applied references do not teach or suggest each and every feature of independent claims 15, 32, 47 and 48, as newly amended. As pointed out in MPEP § 2131, "[t]o anticipate a claim, the reference must teach every element of the claim." Thus, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. v. Union Oil Co. Of California, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987)." Furthermore, Applicants respectfully assert that the rejections of dependent claims 16-18, 21, 26, 31, 33-37, 42-46, and 49-51 should also be withdrawn at least because of their dependencies upon respective newly-amended independent claims 15, 32 and 48 and for the reasons set forth above.

The Rejections under 35 U.S.C. § 103(a)

Claims 20, 23, 38-41 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nomula in view of Koyata. To the extent that these rejections might be reapplied to the claims as newly-amended, it is respectfully traversed as being based on a reference that neither teaches nor suggests the novel combination of features recited in the claims.

As discussed above, Applicants respectfully submit that Nomula fails to teach or suggest each and every feature of the claimed combination of independent claims 15, 32, 47 and 48, as newly amended. Koyata discloses a method for editing management information (U-TOC) of an MD (Mini Disc) but fails to teach or suggest editing visible image pattern to be recorded on the disc surface by using management information contained in the U-TOC. Since Koyata does not cure the deficiencies of Nomula as discussed above with regard to newly-amended independent claims 15, 32, 47 and 48, Applicants respectfully assert that the rejections of claims 20, 23, 38-41 under 35 U.S.C. § 103(a) should be withdrawn at least because of their dependencies upon newly-amended independent claims 15 and 32, as newly-amended, and for the reasons set forth above.

With no other rejections pending, Applicants respectfully assert that claims 15-51 are in condition for allowance.

Conclusion

In view of the foregoing remarks, Applicants respectfully request reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any

issues outstanding after consideration of this response, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution.

Applicants respectfully request an one-month extension. Please charge the amount of \$446 representing \$110.00 for the one-month extension of time fee and \$336 for extra independent claim fee to our Deposit Account No. 50-0310.

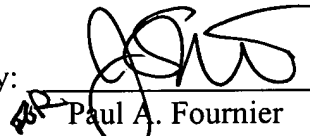
Except for issue fees payable under 37 C.F.R. §1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0310.

Respectfully submitted,

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